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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,673	06/13/2007	Markus Dollinger	2400.0710000/VLC/DAS	1833

26111 7590 06/24/2009  
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EXAMINER

BROOKS, KRISTIE LATRICE

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

06/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/591,673

**Applicant(s)**

DOLLINGER ET AL.

**Examiner**

KRISTIE L. BROOKS

**Art Unit**

1616

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date 5/14/09
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Application***

1. Claims 1-8 are pending.
2. Receipt and consideration of Applicants remarks filed May 14, 2009 is acknowledged.
3. Rejections not reiterated from the previous Office Action are hereby withdrawn.

The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

### ***New Grounds of Rejection Necessitated by Applicant's Amendment***

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/591674 in view of Gesing et al. (US Patent No. 6,964,939).

The instant claim is drawn to a method of selectively controlling weeds of the genus *Apera* in crops by applying the compound of formula (I) in an amount of 2-60 g a.i./ha.

Claim 4 of copending Application No. 10/591674 is drawn to a method of controlling unwanted plants which comprises comprising causing a composition of claim 1 to act on the weeds and/or their habitat.

Gesing et al. teach compounds of general formula (I) are novel herbicides that act as weedkillers (see the entire article, especially the abstract, columns 1-4, column 13 lines 66-67, column 14 lines 1-5, Example 1 (compound No. 2) and claim 1-5). The compounds can be made into herbicidal compositions with customary extenders, emulsifiers and/or surfactants (see the entire article, especially column 15 lines 6-24). The compounds can be used in a method for controlling undesirable vegetation in wild plants or crop plants wherein a compound of formula (I) is allowed to act on undesirable plants such as *Apera* (see the entire article, especially column 14 lines 6-7 and 24-25).

and claims 1-5). The compounds are used in amounts between 1g and 10kg of active compound per hectare of soil (see column 17 lines 20-22).

Table A1 and B5 disclose the instant compound (Example No. (2)) being applied to several weed species at an application rate of 60g of ai/ha (see Table 1 (Ex No. 2) in column 18, Table A1 in columns 23-24 and table B5 in columns 27-28). The instant compound killed the weeds at a rate of 95% or greater.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are drawn to a method of controlling weed unwanted weeds by applying the instant compound of formula I. The instant invention differs from the cited patent by citing a specific species of weeds, *Apera*, to be controlled and the amount of active ingredient to be applied. However, the cited copending application is broader in scope and extends to controlling any undesired vegetation, which would encompass the instant genus of *Apera*. Furthermore, it is well known in the art to apply the instant compound in an amount ranging from 1g and 10kg of active compound per hectare of soil, as suggested by Gesing et al. Thus, the instant amount applied to the plant is an obvious amount to one of ordinary skill in the art. Therefore, both applications are directed to similar subject matter wherein the method comprises controlling weed by applying the instant compound of formula I.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 3 of US Patent No. 6,964,939.

The instant claim is drawn to a method of selectively controlling weeds of the genus *Apera* in crops by applying the compound of formula (I) in an amount of 2-60 g a.i./ha.

Claim 3 of US Pat 6,964,939 is drawn to controlling undesired vegetation by allowing an effective amount of a compound of formula I to act on an undesirable plant.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claim is drawn to a method of controlling weeds of the genus *Apera*, by applying the instant compound of formula I. The instant invention differs from the cited patent by citing a specific species of weeds, *Apera*, to be controlled. However, the cited patent is broader in scope and extends to controlling any undesired vegetation, which would encompass the instant genus of *Apera*. Furthermore, it is well known in the art to apply the instant compound in an amount ranging from 1g and 10kg of active compound per hectare of soil, as suggested by Gesing et al. Therefore, both applications are directed to similar subject matter wherein the method comprises controlling weed by applying the instant compound of formula I.

***Response to Arguments***

Applicant's arguments filed May 14, 2009 have been fully considered but they are not persuasive.

Applicant argues that claim 4 of Application No. 10/591674 is directed to the use of a combination of herbicidal compounds to control weeds whereas the instant claim 1 is directed specifically to controlling *Apera* using a compound of formula I alone.

Applicant further argues that the copending application does not teach the instantly claimed amount of compound to be applied to the weeds.

This is not convincing. First, it should be noted that Applicant does not have any language present that would exclude other material or steps from being present in the instant method step. Although Application No. 10/591674 is drawn to a combination of herbicides, the instant compound is encompassed by herbicidal compounds that can be used to control undesirable plants in Application No. 10/591674. One of ordinary skill in the art can reasonably assume that since the *Apera* species of weeds is encompassed by the broader recitation of unwanted plants, it would have been obvious to practice the instant method with the instant compound recited in claim 1. Moreover, it is well known in the art to apply the instant compound in an amount ranging from 1g and 10kg of active compound per hectare of soil, as suggested by Gesing et al. Thus, Application No. 10/591674 is not patentably distinct from the instant claim because it encompasses the instant method.

Next, Applicant argues that claim 3 of US Patent 6,964,939 is generally directed to controlling undesirable vegetation whereas instant claim 1 specifically recites the control of *Apera* by applying the compound of claim 1. Thus, nothing would lead a person of ordinary skill in the art to use the claimed compound specifically on *Apera*.

However, this is not persuasive. Gesing et al. disclose the instant compound is useful for controlling undesirable vegetation (see the abstract, column 13 lines 66-67, column 14 lines 1-5 and claims 1 and 3). Gesing et al. further recites the instant compound is useful for controlling the undesirable vegetation, such as, the weed species *Apera* (see column 14 lines 6-7 and 24-25). Gesing et al. also teach that the instant compound can be applied in an amount ranging from 1g and 10kg of active compound per hectare of soil (see column 17 lines 20-22). Thus, one of ordinary skill in the art would have reasonably assumed that undesirable vegetation would include the *Apera* species and the instant compound is useful for controlling *Apera* with the amount instantly claimed.

Lastly, Applicant further argues that the compound of formula I in claim I is surprisingly more effective against *Apera* relative to other unwanted vegetation. Applicant provides a 37 C.F.R § 1.132 declaration that discloses compound of formula I in combination with the safener mefenpyr-diethyl. The combination was tested against the *Apera spica-venti*, *Alopecurus myosuroides*, *Phalaris spp.*, and *Poa annua* plant species. The combination of the compound of formula I and safener was shown to be



more effective against *Apera spica-venti* than any other species, when tested at a lower rate of 7.5g a.i./ha.

This argument is not persuasive. First, it should be noted that the instant claims are drawn to an application rate of 2-60 g a.i./ha and not just 7.5 g a.i./ha. Thus, application of the instant compound at any amount between 2-60 g a.i./ha rate would satisfy the instant claim. Applicant agrees that US Patent 6,964,939 discloses several weeds are controlled well at application rates of 60g ai/ha by the instant compound of formula I as well as additional compounds (see page 2 of the 37 C.F.R § 1.132 declaration). Thus, it is established that the instant compound is useful in the control of weeds in the amount instantly claimed.

Second, Applicant has not provided any data that compares the instant composition with the closest prior art composition using the application rate shown in the prior art (see active compound example no. (2) in Tables A1 and B5 of Gesing et al.). Further, Applicant has only provided data at a low end point of the range. Thus, Applicant has not provided data commensurate in scope with the claimed range (2-60g ai/ha). Further Applicant has not provided any side by side comparisons of the claimed invention outside the claimed range that establishes the criticality of the instantly claimed range.

Therefore, Applicant has not provided sufficient evidence commensurate in scope with what is instantly claimed, for one of ordinary skill in the art accurately assess whether an unexpected result occurred as a result of application of the instant compound to the weed *Apera* in the instantly claimed amount.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gesing et al. (WO 01/05788) (US Pat. 6,964,939 is the English translation referenced below in the proceeding art rejection).

Applicant claims a method of selectively controlling weeds of the genus *Apera* in crops of useful plant by applying compound of formula (I).

**Determination of the scope and content of the prior art**

**(MPEP 2141.01)**

Gesing et al. teach compounds of general formula (I) are novel herbicides that act as weedkillers (see the entire article, especially the abstract, columns 1-4, column 13 lines 66-67, column 14 lines 1-5, Example 1 (compound No. 2) and claim 1-5). The compounds can be made into herbicidal compositions with customary extenders, emulsifiers and/or surfactants (see the entire article, especially column 15 lines 6-24). The compounds can be used in a method for controlling undesirable vegetation in wild plants or crop plants wherein a compound of formula (I) is allowed to act on undesirable plants such as *Apera* (see the entire article, especially column 14 lines 6-7 and 24-25 and claims 1-5). The compounds are used in amounts between 1g and 10kg of active compound per hectare of soil (see column 17 lines 20-22).

Table A1 and B5 disclose the instant compound (Example No. (2)) being applied to several weed species at an application rate of 60g of ai/ha (see Table 1 (Ex No. 2) in column 18, Table A1 in columns 23-24 and table B5 in columns 27-28). The instant compound killed the weeds at a rate of 95% or greater.

**Ascertainment of the difference between the prior art and the claims**

**(MPEP 2141.02)**

Gesing et al. do not teach an exemplification of the instant compound being applied to the *Apera* species.

**Finding of prima facie obviousness**

**Rational and Motivation (MPEP 2142-2143)**

One of ordinary skill in the art would have been motivated to apply the instant compound to the *Apera* species because Gesing et al. teach the instant compound is a weedkiller. Although Gesing et al. do not exemplify application of the instant compound to the *Apera* weeds; Gesing et al. suggest that the instant compound is useful for controlling *Apera* (see column 13 lines 66-67 and column 14 lines 6-7 and 24-25).

Thus, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to apply the instant compound of formula (I) to the *Apera* species, since *Apera* is an undesirable weed that the instant compound is capable of acting on as suggested by Gesing et al.

Therefore, the claimed invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made because the prior art is fairly suggestive of the claimed invention.

***Response to Arguments***

Applicant's arguments filed May 14, 2009 have been fully considered but they are not persuasive.

Applicant argues that nothing in Gesing et al. would lead one of ordinary skill in the art to use the claimed compound of formula I in the recited amount to control *Apera* as instantly claimed.

This is not persuasive. Gesing et al. disclose the instant compound is useful for controlling undesirable vegetation, such as *Apera* (see the abstract, column 13 lines 66-67, column 14 lines 1-7 and 24-25, and claims 1 and 3). Gesing et al. further recites the instant compound can be applied in amounts between 1g and 10kg of active compound per hectare of soil (see column 17 lines 20-22). Thus, one of ordinary skill in the art would have reasonably assumed that the instant compound is capable of controlling undesirable vegetation, such as, *Apera*, in the amount instantly claimed.

Next, Applicant further argues that the compound of formula I in claim 1 is surprisingly more effective against *Apera* relative to other unwanted vegetation. Applicant provides a 37 C.F.R. § 1.132 declaration that discloses compound of formula I in combination with the safener mefenpyr-diethyl. The combination was tested against the *Apera spica-venti*, *Alopecurus myosuroides*, *Phalaris spp.*, and *Poa annua* plant species. The combination of the compound of formula I and safener was shown to be more effective against *Apera spica-venti* than any other species when tested at a lower rate of 7.5g/ha.

This argument is not persuasive. As stated above in the arguments section of the double patenting rejection, Applicant did not provide data establishes unexpected superior results of the instant compound on the instantly claimed weed species. Applicant has provided data that tests the instant compound on several weed species at an application rate of 7.5 g ai/ha. The instant compound controlled the weed, *Apera*, better than other weed species. However, this does not establish unexpected results.

One of ordinary skill in the art can reasonably assume that not every compound will control every weed species the same. Some may be more effective on one weed species more than other, while some may require more of the active compound to be effective.

Applicant has not provided any data that compares the instant composition with the closest prior art composition using the application rate exemplified in the prior art (see active compound example no. (2) in Tables A1 and B5 of Gesing et al.). Further, Applicant has only provided data at a low end point of the range. Thus, Applicant has not provided data commensurate in scope with the claimed range (2-60g ai/ha). Further Applicant has not provided any side by side comparisons of the claimed invention outside the claimed range that establishes the criticality of the instantly claimed range.

Therefore, Applicant has not provided sufficient evidence commensurate in scope with what is instantly claimed, for one of ordinary skill in the art accurately assess whether an unexpected result occurred as a result of application of the instant compound to the weed *Apera* in the instantly claimed amount.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTIE L. BROOKS whose telephone number is (571)272-9072. The examiner can normally be reached on M-F 8:30am-6:00pm Est..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KB

/Johann R. Richter/  
Supervisory Patent Examiner, Art Unit 1616